

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re the Application of:               | Confirmation No. 5154             |
| John. F. Boone                          | Group Art Unit: 3715              |
| Application Number: 10/772,449          | Examiner: Kang Hu                 |
| Filed: February 6, 2004                 | Attorney Docket No.: 026096-00006 |
| For: AUTHORIZING TOOL AND METHOD OF USE |                                   |

**REQUEST FOR RECONSIDERATION**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

March 4, 2009

Sir:

The Office Action dated December 29, 2008, has been received and carefully noted. The following remarks are being submitted as a full and complete response thereto. Claims 1-14 and 17-20 are pending in this application. Reconsideration of the rejections of the claims is respectfully requested.

The Office Action rejects claim 1-10, 17, 19 and 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants respectfully traverse the rejection.

In making the rejection, the Examiner states that "a claimed process must contain a sufficient tie to a machine, article of manufacture or a composition of matter" (emphasis added; Office Action, page 2, lines 8-9), and relies on *In re Comiskey*, 84 USPQ2d 1670 (Fed. Cir. 2007). In fact, the Federal Circuit in *In re Comiskey* indicates that when an unpatentable mental process is combined with a machine, the combination may produce patentable subject matter. The Office Action merely infers from this rule that the claimed process must be tied to another statutory subject matter.

In addition, 35 U.S.C. § 101(b) defines “processes” to be “process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.” In other words, “processes” at least include inventions that comprise a series of steps or acts to be performed. In the current application, the series of steps or acts to be performed are claimed for the purpose of providing an authoring tool for enhancing long-term memory. Furthermore, the method or process steps are to be performed via a graphical user interface and at least an input device, which are devices well within the meaning of “machine” of 35 U.S.C. §101.

Given that claims 1-9 and 17-20 are indeed method claims comprising at least a series of steps or acts, Applicants submit that the subject matter recited in claims 1-9 and 17-20 of the present application is well within the category of “processes” of 35 U.S.C. § 101. It is also respectfully submitted that claims 10-14 recite a “device” for providing an authoring tool, and an authoring “tool,” thus fall at least into the categories of “machine” or any “new and useful improvement thereof,” and is therefore patentable subject matter under 35 U.S.C. §101.

As such, it is submitted that the claimed invention is statutory, and withdrawal of the rejection of the claims under 35 U.S.C. § 101 is respectfully requested.

The Office Action rejects claims 1-14 and 17-20 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 7,011,526. A Terminal Disclaimer is filed herewith to obviate the double-patenting rejection. Accordingly, withdrawal of the double-patenting rejection of the claims is respectfully requested.

The Office Action rejects claim 1-14 and 17-20 under 35 U.S.C. § 103(a) as being obvious over Van Schaack et al. (U.S. Patent No. 6,652,283). The rejection is respectfully traversed.

In particular, the present application claims a method and associated device and system for enhancing long-term memory that includes providing a graphical user interface input for receiving content that includes an associated memory retention value which is a specific number measured on a scale, receiving the content, formatting the content for use with a query, wherein the query and response feature includes providing each of the at least one query, evaluating a response to each query, updating the associated memory retention value, scheduling a review of the at least one query based on the associated memory retention value, and prior to the scheduled review of the at least one query, placing the at least one query in a passive display status, wherein the passive display status includes intermittently passively displaying the at least one query and an associated correct response, as recited in independent claim 1, and similarly recited in independent claims 11 and 17.

Van Schaack teaches a system and method for increasing the effectiveness of learning that includes a main engine having a Learn Module, a Review Module and a Test Module (Abstract). Van Schaack further teaches that the memory strength of a user over time is quantitatively measured using information gathered during the user's operation and activity of the Learn Module 21 and the Test Module 23 (Col. 17, lines 1-5). The system 10 in Van Schaack also determines whether the memory strength for a particular item has decreased to a minimum retention level, and reviews that particular item (Col. 17, lines 14-28). The Office Action admits that Van Schaack fails to teach the

claimed feature of placing the at least one query in a passive display status, the Office Action relies on a teaching in Van Schaack that flash cards can be used to enhance a person's knowledge of a given subject matter (Office Action, page 5, line 17 to page 6, line 3). However, Applicants disagree for the following reason.

Van Schaack fails to teach placing the at least one query in a passive display status prior to the scheduled review, as recited in independent claims 1, 11 and 17. Although Van Schaack teaches, in the Background section of the reference, that a "student" may use flashcards to learn a given subject matter, there is no indication, in Van Schaack or in the general knowledge in the art, that the use of these flashcards must be performed prior to a scheduled review performed via the Review Module 22 of Van Schaack. The mere indication that a student may use flash cards to increase their knowledge of a specific subject does not suggest to the ordinary person skilled in the art that flash cards must be used before reviewing the quality of responses in the Review Module 22 of Van Schaack. Thus, combining these two separate teachings of Van Schaack fails to arrive at the subject matter of independent claims 1, 11 and 17. Accordingly, Van Schaack fails to disclose, suggest or render obvious the features of independent claims 1, 11 and 17.

With respect to independent claim 10, Van Schaack teaches that students may use flash cards to increase their knowledge, but does not teach the "means for" placing the query used in the Test Module 23. Van Schaack fails to teach a structure or device to display the query and an associated response. Accordingly, Van Schaack fails to disclose, suggest or render obvious the features of independent claim 10.

For at least these reasons, Applicant therefore submits that independent claims 1, 10, 11 and 17 are allowable over the Van Schaack reference. Claims 2-9, 12-14 and 18-20, are likewise allowable at least for their dependence on patentable claims 1, 11 and 17. and for their added features. Accordingly, all the pending claims are patentable, and withdrawal of the rejection of the claims under 35 U.S.C. §103(a) is respectfully requested.

Should the Examiner determine that any further action is necessary to place this application into better form for allowance, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, referencing Attorney Dkt. No. 026096-00006.

Respectfully submitted,



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Attachment: Terminal Disclaimer

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